

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of: Baokang YANG

Group Art Unit: 1761

Application No.: 10/091,149

Confirmation No.: 5923

Filed: March 4, 2002

Examiner: Becker, Drew E.

For: JUICE BASED BEVERAGE COMPOSITIONS

**RESPONSE TO  
NOTIFICATION OF NON-COMPLIANT APPEAL BRIEF**

**Mail Stop: Appeal Brief-Patents**

Commissioner for Patents

PO Box 1450

Alexandria, VA 22313-1450

Sir:

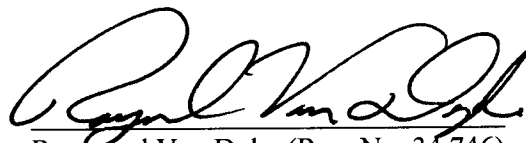
In response to the Notification of Non-Compliant Appeal Brief (the "Notification") mailed February 22, 2008, submitted herewith is an Amended Appeal Brief containing only the corrected sections relating to (1) "Grounds of Rejection To Be Reviewed On Appeal" and (2) "Arguments." As recommended in Items 5 and 6 of the Notification and verified in a communication with the Examiner, only these corrected sections of the Appeal Brief are submitted herewith. With this submission, Applicant respectfully submits that the Appeal Brief is ripe for consideration by the Examiner.

No fee is believed to be due for this submission. Should any fees be required, please charge such fees to Winston & Strawn LLP Deposit Account No. 50-1814.

Respectfully submitted,

March 19, 2008

Date:



Raymond Van Dyke (Reg. No. 34,746)

**WINSTON & STRAWN LLP**

**Customer No. 28765**

202-282-5971

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

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**AMENDED APPEAL BRIEF**

**Mail Stop: Appeal Brief-Patents**

Commissioner for Patents

PO Box 1450

Alexandria, VA 22313-1450

Sir:

In response to the Notification of Non-Compliant Appeal Brief (the "Notification") mailed February 22, 2008, Appellant submits herewith the corrected sections relating to "Grounds of Rejection To Be Reviewed On Appeal" and "Arguments" only. As recommended in the Notification and by the Examiner, only these corrected sections of the Appeal Brief are submitted herewith. The remaining information in the Appeal Brief filed on January 22, 2008 remains unchanged, and Applicant respectfully requests that the Brief be entered at this time and considered on the merits without further procedural delay. Should any further procedural issues remain, Applicant respectfully requests that the matter be immediately brought to the attention of Applicant's representative in this matter, designated below.

## VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Appellant respectfully requests the Board to reverse the following grounds of rejection:

(A) The rejection of claims 1-8, 10-20, 22 and 24 under 35 USC §103(a), as being obvious over U.S. 6,106,874 to Liebrecht et al. (hereinafter "Liebrecht"), in view of GB2335134A to (hereinafter "Burke"); and

(B) The rejection of claim 21 under 35 USC §103(a) as being obvious over Liebrecht, in view of Burke, and further in view of JP 4-311378A to Harada et al. (hereinafter "Harada").

## VII. ARGUMENTS

### **A. The rejection of claims 1-8, 10-20, 22 and 24 under 35 USC §103(a), as being obvious over Liebrecht, in view of Burke**

Claims 1-8, 10-20, 22 and 24 stand rejected under 35 USC §103(a), as being obvious over Liebrecht, in view of Burke.

Liebrecht relates to a beverage as a source of calcium (abstract) does not disclose the use of whey protein hydrolysates. Burke relates to a carbonated sports drink of high caloric value for people engaged in physical activities. Burke states that protein hydrolysates have a problem that they tend to precipitate (page 3, lines 22-28), and thus need specific levels of specific carbohydrates to prevent this precipitation. Burke and Liebrecht are nutritional beverages based on fruit juice, carbohydrate and protein. Can Liebrecht, in view of Burke render claims 1-8, 1-20 and 22-24 unpatentable under 35 U.S.C. §103(a) when protein hydrolysates have a problem that they tend to precipitate and Burke only provides the solution in a specific range of carbohydrate amounts and of carbohydrates of a specific nature?

As admitted by the Examiner, Liebrecht does not disclose the use of whey protein hydrolysates.

Appellant respectfully submits that this rejection is improper because a *prima facie* case of obviousness has not been established. The three elements of a *prima facie* case of obviousness are: 1) some suggestion or motivation to modify the reference or combine the teachings; 2) a reasonable expectation of success; and 3) the prior art references must teach or suggest all the claim limitations. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). Burke relates to a carbonated sports drink of high caloric value people engaged in physical activities, and Liebrecht is specifically for providing calcium supplementation. The mere fact that references can be

combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Neither reference suggests the desirability of the combination since their intended uses are dramatically varied. The Examiner states that since both Burke and Liebrecht are nutritional beverages based on fruit juice, carbohydrate and protein, it would be obvious to combine them. Appellant respectfully disagrees, especially in light of no suggestion in either reference of the desirability of the combination. Appellant respectfully submits that there is no suggestion or motivation in Burke or Liebrecht to modify the reference or combine the teachings. "Something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making" the necessary modification. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1051 5 U.S.P.Q.2d 1434, 1438 (Fed Cir. 1988 ), cert. denied, 488 U.S. 825 (1988)

Turning now to the second element of obviousness, there is no reasonable expectation of success. Contrary to a reasonable expectation of success, Burke states that protein hydrolysates have a problem that they tend to precipitate (page 3, lines 22-28), and thus need specific levels of specific carbohydrates to prevent this precipitation; it should be noted that Burke (page 3, lines 22-28) states that the problem was solved by adjusting the amount and nature of the carbohydrate used but does not elaborate on the nature of that carbohydrate. Further in the present application at page 1, line 11, it describes that "The development of fruit juice based beverages containing proteins, carbohydrates, vitamins, and minerals is very difficult. The interaction of the ingredients, particularly the protein with the minerals and other ingredients, often cause the protein to precipitate and frequently cause the entire composition to become very viscous or to gel. Similarly, these interactions may change the physical or chemical properties of the composition in a way that adversely affects the taste, color, odor, mouth-feel and other physical properties of the composition. These adverse changes may occur at any time but are particularly likely when the composition is heated during processing or when the composition sits on the shelf for extended periods." The prior art can be modified or combined to reject claims as *prima facie* obvious as long as there is a reasonable expectation of success. *In re Merck & Co., Inc.*, 231 USPQ 375 (Fed. Cir. 1986); MPEP 2143.02. In the present case, however, there is no reasonable expectation of success without undue experimentation. Neither reference teaches or suggests that the addition of protein hydrolysates will illicit a clear beverage and not cause the problems of precipitation when added to a composition, as described and claimed in the present invention.

In the Advisory Action, the Examiner has asserted that this element is addressed in Burke at page 3, line 28. However, page 3, line 28 does not address the combination of the present invention as claimed. A reading of Burke would not teach one of ordinary skill in the art how to add protein hydrolysates to any mixture without causing the protein to precipitate and not render a clear composition, Burke only discloses a carbonated beverage that will not precipitate on storage with the components and ratios of components described in Burke. Therefore, combination of Burke and Liebrecht are believed to be not proper.

In the Advisory Action, the Examiner has asserted that this element (a clear beverage and not cause the problems of precipitation) is addressed in Liebrecht at column 1, line 7. However, column 1, line 7 does not address a clear liquid when protein hydrolysates have been added, which, as argued above would likely cause the protein to precipitate and not render a clear composition. Liebrecht at column 1, line 7 only describes a clear beverage with the components and ratios of components described in Liebrecht, which, as admitted by the Examiner does not include whey protein.

Even if Liebrecht and Burke were to be combined, the solution proposed by Appellant would not be achieved since they still would not teach how to combine the ratio of ingredients claimed in claim 1, nor obtain a clear, palatable beverage, without precipitate of the protein.

Because on the above reasons presented hereinabove, Appellant respectfully submits that the Examiner has failed to establish *prima facie* obviousness of independent claim 1. Accordingly, Appellant respectfully requests the Board to reverse the final rejection of claim 1.

Because claims 2-8, 10-20, 22 and 24 depend from claim 1, Appellant respectfully submits that these dependent claims are also patentable over Liebrecht, in view of Burke, at least for the reasons set forth hereinabove. Accordingly, Appellant also respectfully requests the Board to reverse the final rejection of these dependent claims.

**(B) The rejection of claim 21 under 35 USC §103(a) as being obvious over Liebrecht, in view of Burke, and further in view Harada**

Claim 21 stands rejected under 35 USC §103(a), as being obvious over Liebrecht, in view of Burke, and further in view of Harada. Liebrecht and Burke are discussed above and the grounds are herein incorporated. Harada relates to a specific fiber supplement. Can Liebrecht, in view of Burke, and further in view of Harada render claim 21 unpatentable under 35 USC §103(a) when protein hydrolysates have a problem that they tend to precipitate and

Burke only provides the solution in a specific range of carbohydrate amounts and of carbohydrates of a specific nature?

The arguments for claims 1-8, 10-20, 22 and 24 are relevant for claim 21 and are herein incorporated. There is no motivation to combine Liebrecht, Burke and Harada since Liebrecht is specifically for providing calcium supplementation, Burke is specifically a high calorie sports drink and Harada deals with fiber supplementation. Each designed to address very different issues. There must be a teaching in the prior art for the proposed combination or modification to be proper. *In re Newell*, 13 U.S.P.Q.2d 1248 (Fed Cir. 1989). There is no such teaching or suggestion in Liebrecht, Burke or Harada, to combine these references.

Appellant submits that even if a skilled person were to combine the teaching of Liebrecht, Burke and Harada, the solution proposed by Appellant would not be achieved. As described above regarding paragraph 5, that "The development of fruit juice based beverages containing proteins, carbohydrates, vitamins, and minerals is very difficult. The interaction of the ingredients, particularly the protein with the minerals and other ingredients, often cause the protein to precipitate and frequently cause the entire composition to become very viscous or to gel." Also as stated above, Burke states that protein hydrolysates have a problem that they tend to precipitate (page 3, lines 22-28), and thus need specific levels and nature of carbohydrates to prevent this precipitation. Since fiber supplements are generally carbohydrates, the solution of Burke would not teach one of ordinary skill in the art how to add a fiber, not disclosed in Burke, to a solution and not have the protein hydrolysates precipitate. Therefore, the combined references would not teach or suggest how to make a clear, palatable beverage, without precipitate of the protein.

Based on the above-mentioned remarks, Appellant respectfully submits that the Examiner has failed to establish *prima facie* obviousness of claim 21. Accordingly, Appellant respectfully requests the Board to reverse the final rejection of claim 21.

Respectfully submitted,

March 19, 2008

Date:



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